

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

REC'D 07 DEC 2005

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See Form PCT/PEA/416

Applicant's or agent's file reference
PSIC076WO

FOR FURTHER ACTION

International application No.
PCT/EP2004/005391

International filing date (day/month/year)
19.05.2004

Priority date (day/month/year)
02.07.2003

International Patent Classification (IPC) or national classification and IPC
G01F1/704

Applicant
SICPA HOLDING S.A. et al.

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.
3. This report is also accompanied by ANNEXES, comprising:
 - a. ☒ sent to the applicant and to the International Bureau) a total of 4 sheets, as follows:
 - ☒ sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).
 - ☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.
 - b. ☐ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) , containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

Date of submission of the demand

20.11.2004

Date of completion of this report

06.12.2005

Name and mailing address of the international preliminary examining authority:

 European Patent Office
D-80298 Munich
Tel. +49 89 2399 - 0 Tx: 523656 epmu d
Fax: +49 89 2399 - 4465

Authorized Officer

Klein, M-O

Telephone No. +49 89 2399-2736



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Box No. I Basis of the report

1. With regard to the **language**, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This report is based on translations from the original language into the following language, which is the language of a translation furnished for the purposes of:

- ☐ international search (under Rules 12.3 and 23.1(b))
- ☐ publication of the international application (under Rule 12.4)
- ☐ international preliminary examination (under Rules 55.2 and/or 55.3)

2. With regard to the **elements*** of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:

Description, Pages

1-31 as originally filed

Claims, Numbers

1-17 received on 10.11.2005 with letter of 10.11.2005

Drawings, Sheets

1/2, 2/2 as originally filed

☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages
- ☐ the claims, Nos.
- ☐ the drawings, sheets/figs
- ☐ the sequence listing *(specify)*:
- ☐ any table(s) related to sequence listing *(specify)*:

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

- ☐ the description, pages
- ☐ the claims, Nos.
- ☐ the drawings, sheets/figs
- ☐ the sequence listing *(specify)*:
- ☐ any table(s) related to sequence listing *(specify)*:

* If item 4 applies, some or all of these sheets may be marked "superseded."

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Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	9,11-13
	No: Claims	1-8,10,14-17
Inventive step (IS)	Yes: Claims	
	No: Claims	1-17
Industrial applicability (IA)	Yes: Claims	1-17
	No: Claims	

2. Citations and explanations (Rule 70.7):

see separate sheet

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Reference is made to the following documents:

D3: DE 199 01 041 A

D4: US-A-3 894 917

D10: US-A-5 849 590

Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of claims 1 and 17 is not new in the sense of Article 33(2) PCT.

claim 1:

D10 discloses a method for marking a material (explosive material), the method comprising the steps of:

- identifying at least one ion (col. 9, l. 2-42') comprised in the said material at a concentration level of below 50 ppm in the unmarked state (col. 7, l. 57- col. 8, l. 34) state that the marker concentration of a selection of rare elements in natural abundance is between 0.001 ppm and 40 pm)
- selecting a marking composition comprising at least one ion as identified in step 1
- incorporating the marking composition of step 2 into the said unmarked material (abstract; col. 9, l. 12-44)

wherein the concentration level of the said at least one ion in the marked material is increased in step 3 by at least the factor of 3 as compared to the concentration level of

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- ¹ The examining authority wants to stress in this report that **D10 does** disclose ion-marking materials. It is explicitly noted in **D10** (col. 9, l. 23-37) that water soluble ions (as nitrates, chlorides, acetates and citrates) are used as marking materials.

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the ion present in the unmarked material (up to 100 ppm in comparison to average ion concentrations in the material of 1-10 ppm; see also col. 7, l. 57- col. 8, l. 33; col. 9, l. 37-42)

claim 17:

For reasons analogous to those given for claim 1, the subject-matter of independent claim 17 is not new either (col. 4, l. 26: tagging of foodstuff/grain).

2. Varioups dependent claims do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step, see documents D3,D4,D10 and the corresponding passages cited in the search report.

claim 2:	D10:	(col. 10, l. 16-22)
claim 3:	D10:	concentration of rare elements is known (col. 8, l. 8-25)
claims 4-8:	D10:	(col. 8, l. 5-34; col. 9, l. 23-42)
claim 9:	D10:	(col. 4, l. 26: tagging of foodstuff/grain). Subject-matter not inventive; the spilled shipments could also be drugs or pharmaceutical products etc.
claim 10:	D10:	(col. 7, l. 12-22)
claim 11-13:		Not inventive; analysis in D10 can be performed by a wider variety of techniques (e.g. D3, D4)
claim 14:	D10:	(col. 10, l. 16-22)
claims 15-16:	D10:	(col. 10, l. 16-22)